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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,868	08/09/2000	YOSHIO TSUJINO	H4898PCT/U	5240
7590 05/20/2004				
GLENN E J MURPHY HENKEL CORPORATION 2500 RENAISSANCE BOULEVARD SUITE 200 GULPH MILLS, PA 19406		EXAMINER ELHILO, EISA B		
		ART UNIT 1751 PAPER NUMBER		
DATE MAILED: 05/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/601,868

**Applicant(s)**

TSUJINO ET AL.

**Examiner**

Eisa B Elhilo

**Art Unit**

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1 This action is responsive to the supplemental appeal brief filed on 10/07/2003.

2 Upon further review and consideration the prosecution is reopened. Exparte prosecution  
is resumed.

### **NEW GROUND OF REJECTION**

#### ***Claim Rejections - 35 USC § 102***

3 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the  
basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Rondeau et al.  
(WO' 97/39727). Also see the attached English translation document.

Rondeau (WO' 727) teaches a cationic direct dye of (IV) which is identical to the  
claimed formula when in the reference formula (IV), Z denotes a nitrogen atoms or a CH radical,  
A and B denote benzenic or heterocyclic aromatic groups substituted with one or more radical  
such as NR<sub>11</sub>R<sub>12</sub> or OR<sub>11</sub> in which R<sub>11</sub> and R<sub>12</sub> simultaneously or independently of each other  
represent hydrogen, a C<sub>1</sub>-C<sub>8</sub> alkyl radical a C<sub>1</sub>-C<sub>4</sub> hydroxyalkyl radical or a phenyl radical and  
X- denote an anion as claimed in claims 10-12 (see page 10, lines 20-29, formula IV and page  
11, line 1) and oxidative fixing agent (oxidizing agent) (see page 13, line14). Rondeau teaches  
all the limitations of the instant claims. Hence, Rondeau anticipates the claims.

#### ***Claim Rejections - 35 USC § 103***

4 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

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obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rondeau et al. (WO' 97/39727). Also see the attached English translation document.

Rondeau (WO' 727) teaches a composition for coloring hair comprising cationic dyes such as 4-aminophenylazo-2-hydroxy-8-trimethyammoniumnaphthalene chloride which is similar to the claimed compounds as claimed in claim 13 (see page 11, formula 10) and oxidative fixing agent (oxidizing agent) (see page 13, line14), wherein the direct dyes presented in the amounts of 0.1 to 50% or 0.1 to 100% by weight which is overlapped with the claimed percentage amounts as claimed in claims 14, 23 and 25 (see page 13, lines 5-6). Rondeau also teaches a similar method for dyeing hair comprising the steps of applying to the hair a coloring compositions that comprise cationic direct dyes, reducing agents and oxidizing agents as mentioned above (see page 16, lines 4-10) and wherein the coloring composition has a pH in the range of 3 to 12 which is overlapped with the claimed range as claimed in claim 24 (see page 24, claim 22). Rondeau further, teaches a similar devices or kits for dyeing keratin fibers comprising cationic direct dyes as in composition (B), reducing agents as in composition (A) and oxidizing agents as in composition (C) as claimed in claims 15-18 (see page 24, claim 23).

Although Rondeau (WO, 727) teaches a composition for coloring hair comprising cationic dyes and oxidizing agents and method for coloring hair with kits, the reference differs in that does not teach or disclose the specific species of the direct dyes in the claimed amounts as claimed. Further, the reference does not teach the method's steps and kits as claimed.

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However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply such a method for coloring hair using similar coloring composition because the reference teaches the direct dye 4-aminophenylazo-2-hydroxy-8-trimethyammoniumnaphthalene chloride compound, which is an isomer of the claimed, compounds 4-aminophenylazo-2-hydroxy-7-trimethyammoniumnaphthalene chloride. The reference also teaches similar methods and kits for coloring hair, and, thus, the person of an ordinary skill in the art would have obtained the recited claimed compounds within the general disclosure of the reference by applying similar methods and kits with the reasonable expectation of achieving successful composition for coloring hair. Further, the similarities in chemical structure between the prior art and the claimed compounds and which have similar utilities establishes a prima facie case of obviousness. (In re Payne, 203 VSPQ 245).

Furthermore, the applicant has not shown on record the criticality of the method's steps in coloring hair.

### ***Conclusion***

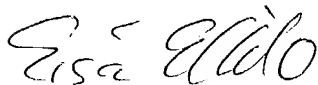
5 Applicant's arguments with respect to the rejection of claims 10-25 under 35 U.S.C. 102(b) as being anticipated by Rondeau (WO, 727), have been considered but are rendered moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eisa Elhilo  
May 17, 2004

  
**Mark Kopec**  
**Primary Examiner**